

Remarks

The Office communication mailed June 4, 2004 asserts that the pending claims are directed to five patentably distinct species of the invention (*i.e.*, avian, hamster, cow, monkey, and dog cells). Applicants provisionally elect the species of monkey cells, with traverse. Claims 43, 44, 45, 49, 54, and 59 read on this species.


The Manual of Patent Examining Procedure sets forth two criteria that must be met to make a proper restriction requirement. First, as stated in 35 U.S.C. § 121, the inventions must be independent or distinct. Second, there must be a “serious burden” on the examiner to justify the restriction. M.P.E.P. § 803. The M.P.E.P. further states that a serious burden may be *prima facie* shown “if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP § 802.02.” On the other hand, “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” M.P.E.P. § 803, emphasis added. In this case, the *prima facie* showing of a serious burden has not been met.

All of the allegedly patentably distinct species of cells are classified in a single class (class 435). Far from imposing a serious burden on the Examiner, it would be relatively easy for all of the claims in this application to be examined together. Thus, search and examination all of the claims could be made without serious burden. In this circumstance, the M.P.E.P. § 802.02 instructs that the claims should not be restricted. This policy should be applied in the present application to avoid unnecessary delay and expense to the applicants and duplicative examination by the Patent Office. At a minimum, claims 47-50 and 52-58 should be examined

together with generic claims 43, 44, 45, and 59; each of these claims is directed to a mammalian cell.

Respectfully submitted,
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